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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/046,568	01/16/2002	Xavier Blin	05725.1018-00	1780

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EXAMINER

VENKAT, JYOTHSNA A

ART UNIT	PAPER NUMBER
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1615

DATE MAILED: 09/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/046,568

Applicant(s)

BLIN ET AL.

Examiner

JYOTHSNA A VENKAT Ph. D

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 98 and 106-120 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 98 and 106-120 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>6/29/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Receipt is acknowledged of letter regarding litigation; amendment and IDS file don 7/23/04 and 6/29/04 respectively. Claims 1-97, 99-105, and claims 106-120 are added. Claims 98 and 106-120 are pending in the application and the status of the application is as follows:

The following new ground of rejection is necessitated by the amendment.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claims 98, and 106-120 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. **This is written description rejection.**

To satisfy the Written description requirement, applicant must convey with reasonable clarity to one skilled in the art, as of the filing date that applicant were in possession of the claimed invention. Applicant's claims are drawn to cosmetic process for making up or nontherapeutically treating nails comprising first polymer which is the genus and the species is polymer of formula I, and when the polymer is defined as "when R⁴ is a direct bond to R³ or another R⁴ so that the nitrogen atom to which both R³ and R⁴ are bonded forms a part of heterocyclic structure defined by R⁴-N- R³", this definition does not comply with the written description requirement. There is no description in the specification for heterocyclic ring

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systems. The same is true for the definition of R3 when it is defined as “when R3 are identical or different and chosen from organic groups comprising atoms chosen from carbon atoms, hydrogen atoms, oxygen atoms and nitrogen atoms”. The only description is for “hydrocarbon group and polyalkylene group. However the specification does not define the carbon atoms for “alkylene” in polyoxyalkylene “. There is no compound described or exemplified for carbon, hydrogen, oxygen and nitrogen or carbon, hydrogen and nitrogen. Therefore it is the position of the examiner that claims employing the above language at the point of novelty, such as applicants’, neither provides those elements required for practicing the inventions, nor “inform the public” during the life of the patent of the limits of the monopoly, asserted. The expression could encompass myriad of heterocyclic compounds and myriad of compounds for R3 and applicants claimed expression represents only an invitation to experiment regarding possible heterocyclic compounds.

2. Claim 115 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

This is new matter rejection.

3. There is no support in the specification for organic solvent being “alkanes having from 6-10 carbon atoms”. The support in the specification is for “linear alkanes having from 6-10 carbon atoms.” Alkanes by definition include “branched “ for which there is no support in the specification “.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 98 and 106-120 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims recite the expression “ process for making up nails”. This expression means applying nail polish. The claims also have another embodiment which is “ process for nontherapeutically treating nails”. The specification does not define the meaning of this and the examiner relied on the dictionary “ Webster’s 3rd edition “ for therapeutic and non and it is the examiners position that the meaning for both the embodiments is same. Therefore claims are ambiguous since both the embodiments are claiming nail polish.

Claim Rejections - 35 USC § 103

6. Claims 98 and 106-120 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of U. S. patents ‘861(’861) and 5,783, 657(‘657) and 5,972,095 (‘95).

(a) Claim construction

There is no definition for “ non therapeutically treating nails”. The examiner relied on Webster’s 3rd edition dictionary for “ therapeutic “ and “ non”. According to the dictionary the meaning of the word “ non-therapeutic “ is not related to any disease of nails”. The claims are drawn to cosmetic process for treating nails of human beings for both embodiments. Therefore, the claims are related to “ nail polish”.

Applicants are notified that the patent ‘861 is a competent reference since the certified translation of the provisional application does not identify at page 1, application serial number

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60/330,767. Applicants are also notified that there is no record of translation foreign priority document.

The application is drawn to cosmetic process for making up nails comprising:

1. Polymer of formula 1
2. Organic solvent
3. Second film-forming polymer
4. Non volatile oil
5. Additives

The patent '861 teaches stable cosmetic emulsion with polyamide gelling agent. This gelling agent is identical to the polymer of formula I. See the abstract, see col.3, lines 20-25 where the patent is relying on patent '657 for the polymer of formula I. see patent '657 cols. 4-6 for the polymer. The patent at col.7, lines 25-38 teach various cosmetic applications. The patent at col.3, lines 1-5 teach the polymer in mineral oil. Mineral oil is a non-volatile oil. The patent at col.3, lines 35-45 teach ingredients 2 and 4. Claim 117 is drawn to volatile solvent being isoparaffin. The patent under example 2 teaches Polyvinylpyrrolidone which is ingredient 3. Claim 111 is drawn to vinyl polymers. The difference is the patent does not teach volatile solvent being alkanes and esters. However, patent '095 teaches nail enamel composition using solvents at col.4, lines 50-65, film-formers at col. 5, lines 30-45. See also the examples.

Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to prepare compositions of '861 and use it as nail polish and combine it with the solvents of '095 expecting beneficial effect to the nails. The motivation to combine the ingredients flows logically from the art for having been used in the same cosmetic art. One of

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ordinary skill in the art would be motivated to use the compositions of '861 as nail polish since the patent teaches colored compositions like lipstick and one of ordinary skill in the art would have a reasonable expectation of success that by applying the compositions of '861 to the nails the nail polish has the advantage of having long wearing and non-smudging properties in view of the same polymer and combining it with the solvents of '095 has the additional advantage that the polish has quick drying time which benefit the consumer. This is a prima facie case of obviousness.

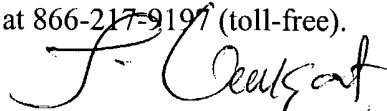
7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A VENKAT Ph. D whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Thursday, 9:30-7:30:1st and 2nd Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THURMAN K PAGE can be reached on 571-272-0602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


JYOTHSNA A VENKAT Ph. D
Primary Examiner
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